

REMARKS

Reconsideration of the rejection of all claims is respectfully requested for the reasons detailed below. The new “new matter” rejection is believed to be totally unfounded in that the claim limitation that the Examiner now points to were in the specification and claims as originally filed, and have remained in the claims to this date. It must be assumed that the Examiner has overlooked some aspect of the past prosecution of this application in making this new rejection. Therefore, the relevant portions of the prosecution history of this application will be summarized below.

Status of the Claims

It should first be noted that in the previous Office Action dated January 29, 2003, claims 2, 3, 5-12, 14 and 17-19 were allowed, and claim 13 was objected to only because it was dependent on a rejected claim, and the Examiner suggested placing claim 13 in independent form. Only claims 1 and 16 were rejected, as being “inherently anticipated” by the Myers reference.

Applicants responded on July 29, 2003. In an effort to expedite the prosecution of the rejected claims to allowance, the limitations of allowed claims 2 and 3 were directly and verbatim carried into claim 1 to more clearly distinguish claim 1 from Myers, and claims 2 and 3 were cancelled as now being redundant. This was clearly explained in the Remarks portion the July 29, 2003 as follows:

Claim 1 has been amended by substituting formula I(b) from claim 3 in place of the structure of formula (I), and all limitations of claims 2 and 3 have been incorporated into claim 1. Claims 2 and 3 have been cancelled as redundant. Claim 13 has been placed in independent form. Otherwise, the claims are of a scope and format as presented with the Amendment and Response dated November 6, 2002.

(Amendment and Response filed July 29, 2003 at page 23). The rejection of composition claim 16 was not understood and was believed to have been in error, in that claim 16 was simply directed toward a pharmaceutical composition comprising the compounds of the allowed compound claims, and reconsideration of the claim 16 rejection was therefore requested (Amendment and Response filed July 29, 2003 at page 25, second paragraph).

All other comments and requests made by the Examiner in the January 29, 2003 Action were addressed and taken care of (including the presentation of a new Abstract). Applicants and the undersigned had every reason to believe that the next paper would be a Notice of Allowance.

Discussion of New Claim Rejections

Instead of a Notice of Allowance, the Office Action of October 22, 2003 finally rejected all claims, including the claims that had previously been allowed, on grounds that the Amendment of July 29, 2003 somehow introduced “new matter,” including a negative limitation (proviso) that was asserted not to have been disclosed in the application as filed. Applicants and the undersigned have carefully studied the July 29, 2003 Amendment for the possibility of some inadvertent error that might have caused the Examiner to issue this Action, but none could be found. Therefore, applicants and the undersigned remain at a loss in trying to understand how the direct, verbatim incorporation of a figure and related definitions (including proviso) from allowed dependent claims 2 and 3 into rejected claim 1, could possibly result in a new matter rejection.

It is presumed that the Examiner made an error, and that this error will already be readily apparent to the Examiner. Nevertheless, detailed support for the asserted “new matter” will be provided below, in case there actually was some misunderstanding.

Specifically, the Examiner now asserts that there is no specification support for the “new” variable R^{2a} and the proviso (negative limitation) removing hydrogen from the scope of R^2 . As explained at page 23 in the Remarks portion of the July 29, 2003 Amendment and Response (quoted above), applicants simply incorporated the limitations from allowed dependent claims 2 and 3 into claim 1, to address the rejection of claim 1 over Myers, and claims 2 and 3 were cancelled as thus becoming redundant.

Starting with the November 6, 2002 Amendment and Response as the reference point, the initial amendments to claims 1-3 simply converted original “use” claims to a proper method format for U.S. prosecution. The compound definitions in method claims 1-3 remained the same as in “use” claims as originally filed.

- The compound of method claim 1 (as in original “use” claim 1) was of formula I, wherein, *inter alia*, the quinazoline ring was substituted by the group $(R^2)_m$, and the linker between the quinazoline ring and ring C was “Z”. These and all other variables of formula I were defined in claim 1.
- The compound of method claim 2 (as in original “use” claim 2) was of formula Ia, with the same ring variables defined as in claim 1, except that $(R^2)_m$ on the quinazoline ring of claim 1 was more specifically shown as R^{2a} at the 6-position and as R^2 at the 7-position of the quinazoline ring of formula Ia. All ring variables had the same definition as in claim 1, except for “the proviso that R^2 is not

hydrogen,” and a full definition was given for the variable R^{2a} that was not in claim 1. It is again emphasized that the compound definitions and structure of formula Ia in method claim 2 were the same as in original “use” claim 2, including the “proviso.”

- The compound of method claim 3 (as in original “use” claim 3) was of formula Ib, which differed from formula Ia (claim 2) by the replacement of linker Z with linker Zb, having the more limited definition of –O– and –S–, but otherwise the definition of R^{2a} was referred back to claim 2 and all other definitions referred back to claim 1. It is again emphasized that the compound definitions and structure of formula Ib in method claim 3 were the same as in original “use” claim 3.

Method claim 1 was rejected in the next Action mailed January 29, 2003, but narrower method claims 2 and 3 were allowed (as well as most other claims as noted above). In the July 29, 2003 Amendment and Response, the limitations of allowed method claims 2 and 3 were brought into method claim 1, which clearly should have led to the allowance of claim 1. This was done by replacing formula I with formula Ib from claim 3 (including the replacement of $(R^2)_m$ by R^2 and R^{2a}), replacing the definition of Z with the claim 3 definition of Zb, deleting the definition of m (now being redundant replacement of $(R^2)_m$ by R^2 and R^{2a}), added the proviso that R^2 is not hydrogen (taken directly from claim 2), and adding the claim 2 definition of R^{2a} .

The Examiner makes the same “new matter” rejection with respect to these groups in compound claim 18, but claim 18 was previously added by the November 6, 2002

Amendment and Response, was allowed in the January 29, 2003 Action, and was not further amended in by the July 29, 2003 Amendment and Response.

Thus, it is clear (and respectfully submitted) that there is nothing introduced by the July 29, 2003 Amendment and Response that could possibly be considered “new matter” relative to the claims that had already been indicated as being allowed in the January 29, 2003 Action.

Nevertheless, the Examiner asserts that there is no support in the specification for the proviso to R^2 and for R^{2a} and its definition now in the claims. The Examiner also asserts at the bottom of page 2 that specification support for R^{2a} is particularly lacking in that it is different from R^2 because “it includes C_{1-3} alkylthio, $R^{5a}(CH_2)_{za}X^{1a}$, etc. which are not in the definition of R^2 .” However, the structure of formula (Ia) is set out on page 18 of the specification and, as in claim 2, recites “with the proviso that R^2 is not hydrogen.” The paragraph bridging pages 18 and 19 gives the complete definition of R^{2a} as in claim 2, including C_{1-3} alkylthio, $R^{5a}(CH_2)_{za}X^{1a}$. These same definitions have been taken from claim 2 into pending claim 1, so clearly there is specification support. The Examiner does not raise an issue with respect to formula (Ib) and the more limited definition of Zb relative to Z in original claim 1, but support is found at specification page 20.

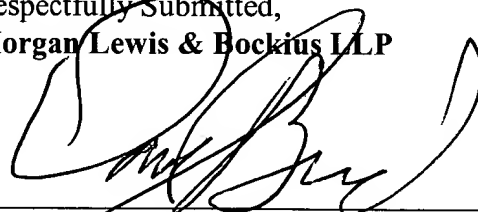
Upon review of the recent history of this application as outlined above, it should be readily apparent that there is no “new matter,” and that the Final Rejection was made in error and should be withdrawn. Nevertheless, if for some reason the Examiner still has any question as to support for the pending claims, the Examiner is urged to telephone the undersigned so that any remaining questions can be expeditiously addressed and overcome.

The Examiner's attention is called to the further Information Disclosure Statement being submitted herewith, with a form PTO-1449 correctly citing published PCT Application WO98/14431, and submitting a copy for the Examiner's consideration. This reference was mis-cited as WO96/14331 in the form PTO-1449 accompanying the July 29, 2003 Information Disclosure Statement, and the wrong reference copy was submitted. The Examiner is respectfully requested to consider this additional reference, and acknowledge such consideration by initialing the form PTO-1449 where indicated, and returning an initialed copy to the undersigned.

A Notice of Allowance is believed to be in order, and is respectfully requested.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully Submitted,
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